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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/632,897	08/07/2000	David T. Chang	M-9251US	2953

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EXAMINER

BURGESS, BARBARA N

ART UNIT PAPER NUMBER

2157

DATE MAILED: 10/21/2004

Please find below and/or attached an Office communication concerning this application or proceeding.

## Office Action Summary

Application No.

09/632,897

Applicant(s)

CHANG ET AL.

Examiner

Barbara N Burgess

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

### Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

### Status

- 1) ☒ Responsive to communication(s) filed on 15 August 2004.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

### Disposition of Claims

- 4) ☒ Claim(s) 1-32 is/are pending in the application.
- 4a) Of the above claim(s) \_\_\_\_\_ is/are withdrawn from consideration.
- 5) ☐ Claim(s) \_\_\_\_\_ is/are allowed.
- 6) ☒ Claim(s) 1-32 is/are rejected.
- 7) ☐ Claim(s) \_\_\_\_\_ is/are objected to.
- 8) ☐ Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

### Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on \_\_\_\_\_ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

### Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some \* c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
  - ☐ Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- \* See the attached detailed Office action for a list of the certified copies not received.

### Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☐ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)  
Paper No(s)/Mail Date \_\_\_\_\_
- ☐ Interview Summary (PTO-413)  
Paper No(s)/Mail Date. \_\_\_\_\_
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: \_\_\_\_\_

### DETAILED ACTION

This Office Action is in response to amendments filed August 15, 2004. Claims 1-32 are presented for further consideration.

#### ***Claim Rejections - 35 USC § 102***

1. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

2. Claims 1, 3, 7-21, 26- 32 are rejected under 35 U.S.C. 102(e) as being anticipated by Diwan (US Patent 6,801,936).

As per claim 1, 17, 21, 29, Diwan discloses a method and database for customizing a structured document for delivery to an Internet appliance, comprising:

- Identifying information units in said structured document (column 1, lines 25-30, 35-40, column 2, lines 4-7, 48-52, column 3, lines 15-18, 30-33);
- Selecting one or more of said information units for delivery (column 5, lines 31-34, 50-59, 66-67, column 6, lines 1-5);
- Creating in a database a second structured document including said one or more of said information units (column 1, lines 48-52, 58-60, column 2, lines 44-48, column

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4, lines 10-23, 38-40, 46-50, 61-65, column 5, lines 1-10, 38-45, column 6, lines 6-8); and

- Delivering said second structured document to said Internet appliance (column 1, lines 60-63, column 2, 45-48, column 6, lines 17-20).

As per claim 3, Diwan discloses a method as in Claim 1, further comprising creating a menu including said information units, said menu being adapted for selection by a user and being presented to said user on a graphical display (column 3, lines 47-50, column 5, lines 27-30).

As per claim 7, Diwan discloses a method as in Claim 1, further comprising, prior to said identifying, specifying said structured document from by a uniform resource locator (URL) (column 2, lines 46-47, 59-61, column 3, lines 8-11).

As per claims 8, 15, 26, Diwan discloses a method and database as in Claims 1 and 21, further comprising, prior to said identifying, selecting said structured document from a list of bookmarks (column 3, lines 47-50, column 5, lines 27-30).

As per claim 9, Diwan discloses a method as in Claim 1, wherein said Internet appliance includes means for determining the Internet appliance's geographical location (column 4, lines 52-60).

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As per claim 10, Diwan discloses a method as in Claim 9, further comprising including in said second document pre-configured resources (column 5, lines 27-35).

As per claim 11, Diwan discloses a method as in Claim 10, wherein said pre-configured resources comprises location-specific information (column 4, lines 55-60).

As per claim 12, Diwan discloses a method as in Claim 10, wherein said pre-configured resources are updated at specified time intervals (column 3, lines 30-34).

As per claim 13, Diwan discloses a method as in Claim 1, wherein said second document is adapted for display on said internet appliance in accordance with a profile of said internet appliance (column 1, lines 60-63, column 2, 45-48, column 6, lines 17-20).

As per claim 14, Diwan discloses a method as in Claim 13, further comprising, prior to said selecting, creating said profile of said Internet appliance (column 4, lines 45-55).

As per claims 16, 27, Diwan discloses a method and database as in Claims 1 and 21, wherein said second structured document is associated in said database with a specified user (column 4, lines 39-55).

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As per claim 18, Diwan discloses a database as in Claims 17, further comprising a channel record associated with said user client record, said channel representing a pre-configured resource (column 4, lines 37-60).

As per claim 19, 28, Diwan discloses a method database as in Claims 17 and 21, further comprising a site record associated with said user client record, said site record representing a specified resource (column 4, lines 37-60).

As per claims 20, 30-32, Diwan discloses a method and database as in Claims 19 and 29, further comprises a customization record associated with said site record, said customization record representing modification of said resource in accordance with said device profile record (column 4, lines 37-60).

### ***Claim Rejections - 35 USC § 103***

3. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

4. Claim 2 is rejected under 35 U.S.C. 103(a) as being unpatentable over Diwan (US Patent 6,801,936) in view of Katariaya et al. (hereinafter "Kat", US 2002/0091789 A1).

As per claim 2, Freeman does not explicitly disclose a method as in Claim 1, wherein said second structured document comprises an XML document. However, the use and advantages for using such document is well known to one skilled in the relevant art at the time the invention was made as evidenced by Kat (paragraph [0028]).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate the use of an XML document in Diwan's method in for industries to create their own customized markup languages for exchanging information.

5. Claims 4-6, 22-23, 25 are rejected under 35 U.S.C. 103(a) as being unpatentable over Diwan in view of Feinleib.

As per claims 4-6, 22-23, 25, Diwan does not explicitly disclose a method as in Claim 1, wherein said Internet appliance comprises a personal digital assistant. However, the use and advantages for using a pda is well known to one skilled in the relevant art at the time the invention was made as evidenced by Feinleib (column 1, lines 25-35).

Therefore, one of ordinary skill in the art at the time the invention was made would have found it obvious to implement or incorporate sending to a personal digital assistant in Diwan's method in order to receive email messages.

### ***Response to Arguments***

#### **The Office notes the following arguments:**

(a) Applicants also note that Freeman is continuation-in-part application that claims priority from U.S. Patent App. No. 09/335,372, which was filed on June 17, 1999.

Applicants have noted that U.S. Patent No. 6,181,334 and No. 5,724,091 from which Freeman also claims priority contain disclosures that differ significantly from Freeman's.

(b) Applicants note that the application for Freeland was filed August 2, 2002.

Applicants note that Freeland is a continuation application that claims priority from U.S. Patent App. No. PCT/AU01/00111, which was filed on Feb. 2, 2001. Both of these filing dates are after the Aug. 7, 2000 filing date of the present application.

#### **In response to:**

(a)-(b) The applicant's arguments are moot in view of new grounds of rejection.

### ***Conclusion***

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Barbara N Burgess whose telephone number is (703) 305-3366. The examiner can normally be reached on M-F (8:00am-4:00pm).

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Ario Etienne can be reached on (703) 308-7562. The fax phone number for the organization where this application or proceeding is assigned is (703) 872-9306.




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Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 305-3900.

Barbara N Burgess  
Examiner  
Art Unit 2157

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SALEH NAJJAR  
PRIMARY EXAMINER